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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,872	10/18/2004	Po-Chieh Hung	04735/LH	6569
1933	7590	04/01/2009	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708			NGUYEN, HUY THANH	
			ART UNIT	PAPER NUMBER
			2621	
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			04/01/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/511,872	HUNG, PO-CHIEH	
	<b>Examiner</b>	<b>Art Unit</b>	
	HUY T. NGUYEN	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____ .                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/18/04</u> .  | 6) <input type="checkbox"/> Other: ____ .                         |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 11 direct to information on a medium . Since the information do not provide any functional relationship to the medium to control the medium for accessing the information or impart to any software and hardware structural components to perform certain function that is processed by a computer , the information do not make themselves the statutory. See MPEP 2100.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1,3-5 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Robinson et al (5,029,313).

Regarding claims 1,9 and 11, Robinson discloses an information recording method and an apparatus (Fig. 1) having means for perform the method comprising steps of:

creating an identification information specific to either one of an image information containing an image datum or a recording medium; and  
recording the image information and the identification information on the recording medium, by corresponding the image information and the identification information to each other (column 2, lines 60-68, column 3, 30-45, Figs. 5,7)..

Regarding claim 3, Robinson teaches storing the corresponded image information and identification information in a storage device, by corresponding the image information and the identification information to each other (Figs. 5,7).

Regarding claim 4, Robinson teaches the identification information includes:  
an information of an owner of the recording medium; an information of a recording device for recording the image information and the identification information on the recording medium; and  
an information of at least one of an area and time related to the recording medium (Figs. 5,7).

Regarding claim 5, Robinson teaches the identification information includes:  
information of a color conversion process of the image information (Fig. 7).

5. Claims 1,3,9 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamagishi (5,610.723).

Regarding claims 1,9 and 11, Yamagishi discloses an information recording method and an apparatus (Fig. 1) having means for perform the method comprising steps of:

creating an identification information specific to either one of an image information containing an image datum or a recording medium; and  
recording the image information and the identification information on the recording medium, by corresponding the image information and the identification information to each other (Fig. 19, column 40, line 47 to column 41, line26) .

Regarding claim 3, Yamagishi teaches a step of:

storing the corresponded image information and identification information in a storage device, by corresponding the image information and the identification information to each other (column 40, line 47 to column 41, line 26).

6. Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Schuetzle (6,762,791).

Regarding claim 10, Schuetzle disclose an information recording system (Fig.1, 8, column 5, lines 35-47, column 6, lines 14-45, column 7, lines 15-25, column 8, line 43 to column 9, line 45) , comprising an information recording terminal and a control device, both of which are connected each other via a network, wherein the information recording terminal includes:  
a first transmission device for transmitting an issuing request of an identification information to the control device;

a first receiving device for receiving the identification information from the control device;

an identification information providing device for providing the received identification information to at least one of an image information including image data and a recording medium; and

a recording device for recording the image information and the identification information in the recording medium by corresponding the image information and the identification information to each other (column 5, lines 25-40, column 9, lines 30-45; and wherein the control device includes:

a second receiving device for receiving the issuing request of the identification information from the information recording terminal;

an identification issuing device for issuing the identification information based on the received issuing request; and

a second transmission device for transmitting the identification information to the information recording terminal.

7. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Haneda (6,483,602).

Regarding claims 1, 9 and 11, Haneda discloses an information recording method and apparatus for performing the method, comprising steps of: creating an identification information specific to either one of an image information containing an image datum or a recording medium; and

recording the image information and the identification information on the recording medium, by corresponding the image information and the identification information to each other (column 4, Figs. 13,15-16)columns 6-7) .

Regarding claim 2, Haneda teaches encoding the created identification information (Figs. 15-16).

Regarding claim 3, Haneda teaches storing the corresponded image information and identification information in a storage device, by corresponding the image information and the identification information to each other (Figs. 15-16).

Regarding claim 4, Haneda teaches the information recording method in claim 1, wherein the identification information includes:

an information of an owner of the recording medium; an information of a recording device for recording the image information and the identification information on the recording medium; and

an information of at least one of an area and time related to the recording medium (column 15, lines 15-50).

Regarding claim 5, Haneda teaches the identification information includes: information of a color conversion process of the image information.(Fig. 17, column 22).

Regarding claim 6, Haneda teaches in the image data are those which are read out from a second recording medium (film, user disc, laboratory medium, column 4, Figs. . 15-16) other than the recording medium, and the identification information includes at least either one of DX code information or serial

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number information, which are read from the second recording medium (column 15, lines 30-45).

Regarding claims 7 and 8, Haneda teaches the identification information is recorded as visible information on some part of the recording medium and the visible information is recorded using color which is easily identified (Figs. 6-7).

Regarding claim 10, Haneda (6,483,602) disclose an information recording system (Fig. 13.15 and 16, column 1, lines 15-40, column 4, column 20), comprising an information recording terminal and a control device, both of which are connected each other via a network,

wherein the information recording terminal includes:

a first transmission device for transmitting an issuing request of an identification information to the control device;

a first receiving device for receiving the identification information from the control device;

an identification information providing device for providing the received identification information to at least one of an image information including image data and a recording medium; and

a recording device for recording the image information and the identification information in the recording medium by corresponding the image information and the identification information to each other; and wherein the control device includes:

a second receiving device for receiving the issuing request of the identification information from the information recording terminal;

an identification issuing device for issuing the identification information based on the received issuing request; and

a second transmission device for transmitting the identification information to the information recording terminal.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al in view of Manico et al (6,714,736) .

Regarding claims 7 and 8, Robinson fails to specifically teach that some part of the identification information is visible. Manico teaches recording some part of

identification information is visible (Figs. 2 and 4-5). It would have been obvious to one of ordinary skill in the art to modify Robinson with Manico by recording the visible information on the medium of Robinson as additional information for the medium of Robinson

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571)272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Q. Tran can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HUY T NGUYEN/  
Primary Examiner, Art Unit 2621